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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/653,699	09/02/2003	David J. Brown	213828013US4	3482

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EXAMINER	
LE, UYEN CHAU N	
ART UNIT	**PAPER NUMBER**
2876	

DATE MAILED: 06/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/653,699	BROWN ET AL.	
	Examiner	Art Unit	
	Uyen-Chau N. Le	2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 March 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *8-12,22-25,27-31 and 45-55* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *8-12, 22-25, 27-31 and 45-55* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Prelim. Amdt/Amendment

1. Receipt is acknowledged of the Amendment filed 03/16/2006.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35

U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 8-12, 25, 27-31, 45-47 and 50-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beach et al (US 6,116,402) in view of Alonso (US 5282651 A).

Re claims 8-12, 25, 27-31, 45-47 and 50-55: Beach et al discloses a voucher configured to assist in distinguishing unauthorized duplicate or counterfeit vouchers, the voucher comprising: a flexible and elongate substrate (fig. 1) in connection with a coin counting machine and configured to receive a first indicia 124a on the substrate; a second indicia 124b on the substrate; the coin counting machine provides a total value related to a plurality of randomly received coins (fig. 1); at least one of the first indicia 124a and second indicia 124b indicating a value of the voucher (fig. 1; col. 4, lines 17-39); a third indicia (e.g., 217.93) on the substrate, the third indicia being at least partially obscured by the second indicia (fig. 1).

Beach et al fails to teach or fairly suggest the second indicia is thermally responsive at an activation temperature of at least 75 degrees Fahrenheit; wherein rubbing adjacent to the mark with an object will render the mark visible; wherein the substrate includes a first surface opposite a second surface,

wherein the first indicia is on the first surface and the second indicia is on the second surface; wherein the thermally responsive second indicia is configured to respond to human touch; and wherein the thermally responsive second indicia is configured to respond to human breath; respectively.

Alonso teaches a trading card made of a sheet of paper (col. 3, lines 55+ and col. 4, lines 61) comprises a primary indicia (i.e., the soldier 12), a secondary indicia 18 in area 16, wherein the secondary indicia becomes invisible (i.e., transparent) when applying heat to the area 16 by "rubbing between the thumb and index finger" to show a third indicia 20, which is obscured by the secondary indicia 18 (figs. 1 & 2; col. 3, line 49 through col. 4, line 60).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Alonso into the system as taught by Beach et al in order to provide Beach et al with a more secure system wherein the indicia made difficult to copy, duplicate due to the thermal responsive ink. Furthermore, such modification would assist in distinguishing counterfeit vouchers due to the color changing of the indicia upon changing the temperature, and therefore an obvious expedient.

5. Claims 22-24 and 48-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beach et al as modified by Alonso as applied to claim 8 above, and further in view of Silverschotz et al (US 5137304 A). The teachings of Beach et al as modified by Alonso have been discussed above.

Re claims 22-24 and 48-49: Beach et al/Alonso has been discussed above, but is silent with respect to a plurality of perforations in the substrate defining a pattern.

Silverschotz et al teaches a coupon [22, 23] having perforations 30 arranged in a binary pattern (figs. 2-4; col. 3, lines 21-56).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the perforations pattern of Silverschotz et al into the system as taught by Beach et al/Alonso in order to provide Beach et al/Alonso with a more secure system preventing the coupon/voucher from being duplicated. Furthermore, such modification would provide Beach et al/Alonso with the ability to determine which coupon has redeemed and to rapidly machine sorting of large numbers of redeemed coupons.

Response to Arguments

6. Applicant's arguments filed 03/16/2006 have been fully considered but they are not persuasive.

7. In response to the Applicant's argument to "... To establish a prima facie case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings..." (p. 7, line 14 through p. 8, line 7 and p. 9, last paragraph), the examiner respectfully submits that, "It is not necessary that the references actually suggest, expressly or in so many words, changes or possible improvements. All that is required that the invention was made by applying knowledge clearly present in the prior art." In re Scheckler, 58 CCPA 936, 438 F.2d 999, 168 USPQ 716 (19971).

8. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in

the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the primary reference to Beach et al discloses a voucher (i.e., inherently in form of paper) to assist in distinguishing unauthorized duplicate or counterfeit having first, second and third indicia. Beach et al however is silent with respect to the second indicia is a thermally responsive indicia. The secondary reference to Alonso teaches a trading which can be made of paper (col. 4, lines 60+) having a second indicia that is invisible when applying heat to it by rubbing between the thumb and index finger to show a third indicia. It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to utilize the thermally responsive ink used for the second indicia of the paper trading card of Alonso for the second indicia of the paper voucher as taught by Beach et al for security purposes (i.e., preventing duplicated and/or counterfeit). Accordingly, the claimed limitation, given the broadest reasonable interpretation, Beach et al in view of Alonso meets the claimed invention (see the rejection above).

For the reasons stated above, the Examiner believes that a proper prima-facie case of obviousness has been established. Therefore, the Examiner has made this Office Action final.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Uyen-Chau N. Le whose telephone number is 571-272-2397. The examiner can normally be reached on maxi-flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 571-272-2398. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Uyen-Chau N. Le
Primary Examiner
Art Unit 2876

May 30, 2006